REMARKS

Claims 1 and 3-18 are pending in the present application. The Examiner has rejected claim 3 under 35 U.S.C. §112, and has rejected claims 1-18 under 35 U.S.C. §103(a). The Examiner also presented an interpretation of claims 4 and 11 to avoid a rejection under 35 U.S.C. §101. Applicant has amended claim 3. No new matter has been introduced.

Section 101 Rejection

The Examiner interpreted the word "units" appearing in claims 4 and 11 as explicitly including hardware elements, to place the claimed invention into a statutory category. While this may be one interpretation of the claims, Applicant urges that the Examiner's interpretation is unnecessarily limiting, and that the "units" of claims 4 and 11 need not be separate, explicit hardware units. As described in paragraph [0049], this description is provided to enable better understanding of these elements. These units need not be physically separated into such units as described. Further, although the IP information extraction unit, the IP information analyzing unit, and the E-mail receiving/transmitting unit are described as separate units, these elements can be provided in a single unit, in which case these units could be implemented as software units. Applicant urges that under *State Street Bank & Trust Co. v. Signature Financial Group, Inc.,* 149 F.3d 1368 (Fed. Circ. 1998), the Federal Circuit held that a computer program can constitute statutory subject matter under section 101 if it produces a useful, concrete and tangible result. A system and method for analyzing and utilizing intellectual property information does provide useful, concrete and tangible results.

Section 112 Rejection

Claims 3 was rejected under 35 U.S.C. §112, second paragraph as being indefinite. In particular, the Examiner objected to the phrase "the research center PCs" as lacking antecedent basis. Applicant has amended claim 3 so that this phrase reads "the

research center analyzing unit", which has an antecedent basis in claim 1. Reconsideration and withdrawal of this section 112 rejection are respectfully requested.

Section 103 Rejections

Claims 1 and 3 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,721,910 (Unger, *et al.*) in view of U.S. Patent Application Publication No. 2003/0033295 (Adler, *et al.*).

Claims 4-17 were rejected under 35 U.S.C. §103(a) as being obvious over Unger in view of Adler and further in view of U.S. Patent No. 5,862,223 (Walker, *et al.,*).

Claim 18 was rejected under 35 U.S.C. §103(a) as being obvious over Unger in view of Adler and Walker, and further in view of U.S. Patent No. 6,088,765 (Ohtsuka).

Regarding claim 1, Applicant urges that, at the very least, the combination of Unger and Adler, and regarding claims 4 and 11, the combination of Unger, Adler and Walker, fails to disclose or suggest a *method for analyzing and utilizing intellectual property (IP) information* that includes *transmitting the first IP information converted in the standard form to a research center analyzing unit; . . . accessing the Internet websites and extracting second IP information corresponding to the first IP information upon a request for detailed information; . . . transmitting the second IP information converted in the standard form to the research center analyzing unit, and . . . determining if third IP information has been received from the research center analyzing unit, the third IP information including technical analyses and opinion contents*, as essentially recited in claims 1, 4 and 11.

Unger is directed to a database and a method of producing that database which can be used to determine the meaning of scientific or technical documents, and to assign the technical documents to one or more scientific or technical categories within a multidimensional hierarchical model which reflects the business, scientific or technical interests of a business, scientific or technical entity or specialty. This database disaggregates a set of patents and/or technical documents into discrete technical

categories by use of a set of pre-defined search protocols which match the scientific or technical concepts within the model. The pre-defined search strategies automatically categorize the set of technical documents to fit the multidimensional hierarchical model of a scientific or business discipline. The categorization may then be used by the relational database to identify trends and discontinuities in the research efforts represented by the technology in the underlying technical documents and/or patents. The categorization may also be used to allow the technical experts to examine the underlying documents and/or abstracts and/or claims which contribute to these trends and discontinuities. In order to create this database, the computer system has a pre-defined model of the overall scientific or business discipline and has analyzed the technical content of each patent or technical document with respect to that model. This Technical Subject Hierarchy is used to create a set of sophisticated expert technical searches, using technical indexing along with the text of the patent abstracts and/or the patent claims and/or the technical document. An expert search is created to identify patents or technical documents that are pertinent to each individual category within the Customized Technical Subject Hierarchy and the results of these searches are electronically stored in tables. The set of expert searches represented by Stage IV can be automatically executed against a new set of patents and/or technical documents.

However, <u>Unger</u> does not disclose or suggest *an IP information extraction unit, an IP information analyzing unit,* or *a research center analyzing unit,* as recited in claims 1, 4, and 11, or the steps of *extracting first IP information according to a search strategy; transmitting the first IP information . . . to a research center analyzing unit; . . . determining if third IP information has been received from the research center analyzing unit, the third IP information including technical analyses and opinion contents . . . accessing the Internet websites and extracting second IP information corresponding to the first IP information upon a request for detailed information; and . . . transmitting the second IP information . . . to the research center analyzing unit,* as essentially recited in claims 1, 4, and 11. <u>Unger</u> only discloses a database and methods for producing and maintaining that database.

The Examiner acknowledged that Unger fails to disclose discarding information determined to be not related to at least one project, but then cites Adler as disclosing a relevancy filter. Adler is directed to a computer implemented electronic records system and a data processing system for automatically maintaining an electronic laboratory records system. However, Applicant urges that Adler fails to disclose or suggest a *an IP information extraction unit, an IP information analyzing unit,* or *a research center analyzing unit,* or Applicant's sequence of steps, and thus fails to rectify the deficiencies of Unger.

Thus, Applicant urges that since the combination of Unger and Adler fails to disclose or suggest all limitations of claim 1, this claim is not obvious over Unger and Adler. Reconsideration and withdrawal of this section 103 rejection are respectfully requested.

Regarding claims 4 and 11, Examiner acknowledged that Unger and Adler fail to disclose a system with an email receiving/transmitting unit, but then cites Walker as disclosing this limitation. However, Walker is directed to managing communications between an expert having particular qualifications and an end user seeking a solution to an expert request. Walker fails to rectify the deficiencies of Unger and Adler discussed above.

Thus, Applicant urges that since the combination of Unger, Adler and Walker fails to disclose or suggest all limitations of claims 4 and 11, these claims are not obvious over Unger, Adler and Walker. Reconsideration and withdrawal of these section 103 rejections are respectfully requested.

Claims 3, 5-10, and 12-17 depend from claims 1, 4 and 11, respectively, and are thus patentable for at least the same reasons as claims 1, 4 and 11. Reconsideration and withdrawal of this rejection are respectfully requested.

Regarding claim 18, the Examiner acknowledged that none of Unger, Adler, and Walker teach a system in which *predetermined intervals are determined based on the number of times a user connects to the computer-based system for analyzing and utilizing*

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IP information, but then cited <u>Ohtsuka</u> as disclosing this limitation. <u>Ohtsuka</u> is directed to a removable medium data storage apparatus that can read and store data. However, Applicant urges that <u>Ohtsuka</u> fails to rectify the deficiencies of <u>Unger</u>, <u>Adler</u>, and <u>Walker</u> as discussed above. Since the combination of <u>Unger</u>, <u>Adler</u>, <u>Walker</u> and <u>Ohtsuka</u> fails to disclose or suggest all claimed limitations of claim 18, a *prima facie* case of obviousness of claim 18 over <u>Unger</u>, <u>Adler</u>, <u>Walker</u> and <u>Ohtsuka</u> cannot be maintained. Reconsideration and withdrawal of this section 103 rejection are respectfully requested.

CONCLUSION

Applicant urges that amended claims 1 and 3-18 are in condition for allowance for at least the reasons stated. Early and favorable action on this case is respectfully requested.

Respectfully submitted,

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